

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 9

HRW

11/15/00

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Eagle & Taylor Company

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Serial No. 75/446,093

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Raymond J. Lillie of Carella, Byrne, Bain, Gilfillan,  
Cecchi, Stewart & Olstein for applicant.

Alex S. Keam, Trademark Examining Attorney, Law Office 114  
(K. Margaret Le, Managing Attorney).

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Before Hairston, Chapman and Wendel, Administrative  
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Eagle & Taylor Company has filed an application to  
register the mark BOSTONIAN for "decorative glass panels  
for residential steel doors."<sup>1</sup>

Registration has been finally refused under Section  
2(d) of the Trademark Act on the ground of likelihood of  
confusion with the registered mark BOSTONIAN for "wooden

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<sup>1</sup> Serial No. 75/446,093, filed March 6, 1998, claiming first use  
dates of October 28, 1991.

interior and exterior doors and door skins of molded wood fiber material."<sup>2</sup>

The final refusal has been appealed and both the applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*<sup>3</sup> factors which are relevant under the circumstances. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Here the marks are identical, the word BOSTONIAN. As we turn to the goods, we are guided by the well-recognized principle that the greater the degree of similarity in the marks, the lesser is the degree of similarity that is required of the goods on which the marks are being used in order to support a likelihood of confusion. If the marks are the same, as here, there need only be a viable

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<sup>2</sup> Registration No. 1,831,354, issued April 19, 1994, Section 8 & 15 affidavits accepted and acknowledged, respectively.

<sup>3</sup> See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

relationship between the goods. See *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

The Examining Attorney argues that such a relationship exists in that both wooden and steel doors are goods which may emanate from a single source; that applicant's decorative glass panels are used with doors; that both doors and door panels may travel in the same channels of trade; and that the conditions surrounding the marketing of the respective goods may be such that the goods would be encountered by the same purchasers who might assume a common source for both.

As pointed out by the Examining Attorney, applicant has failed to make any arguments whatsoever with respect to the issue of likelihood of confusion. Applicant's only contention is that applicant used its mark in interstate commerce prior to the date of first use set forth in the cited registration.<sup>4</sup> Inasmuch as priority of use is not germane to applicant's right to register in an *ex parte* proceeding, the Examining Attorney correctly refused to consider this argument and we do the same. See *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (CCPA 1971).

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<sup>4</sup> Applicant's further request that the appeal be suspended until the Office determined the acceptability of the Section 8 affidavit filed by registrant on May 13, 1999 is to no avail. The affidavit was accepted on September 21, 1999 and accordingly the registration is valid and subsisting.

While we will not consider the likelihood of confusion to have been conceded by applicant, we are without any substantive arguments to the contrary.

Moreover, we note that it is not necessary that the goods of applicant and registrant be similar or even competitive to demonstrate a viable relationship between the respective products. It is sufficient if the goods are either related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used therewith, give rise to the mistaken belief that they emanate from, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

Although registrant's products are wooden doors whereas applicant's decorative glass panels are intended to be used with steel doors, we find it reasonable to assume that doors in general and decorative panels for use in doors, whether wooden or steel, would travel in the same channels of trade. As such, the same purchasers would be likely to encounter both wooden and steel doors and decorative panels for the same and, if the same mark is used for both doors, whether wooden or steel, and

decorative panels for doors, we find it likely that these purchasers might assume a common source for both types of products. Applicant has failed to submit any rebuttal argument or evidence which might lead us to a different conclusion.

Accordingly, we find a sufficient relationship exists between the respective goods that the use of identical marks therewith would lead to a likelihood of confusion.

Decision: The refusal to register under Section 2(d) is affirmed.

P. T. Hairston

B. A. Chapman

H. R. Wendel

Administrative Trademark Judges,  
Trademark Trial and Appeal Board

**Ser No.** 75/446,093